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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 28

Application Number: 09/206,627
Filing Date: December 7, 1998
Appellant(s): Allen, Jr.

Howard L. Speight
For Appellant

EXAMINER'S ANSWER

This is in response to Appellant's brief on appeal filed on January 11, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

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(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The Appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The Appellant's statement of the grouping of claims in the brief is correct.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,777,580	JANKY ET AL.	7-1998
5,826,195	WESTERLAGE ET AL.	10-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 26-33 are rejected under 35 U.S.C. 102(e) as being anticipated by **Janky et al.** (U.S. Patent # 5,777,580).

Consider **claim 26**, Janky et al. clearly show and disclose a vehicle location system (triggerable location-reporting apparatus) comprising:

a location determination system (LDS) receiver/processor 31 (location-signal generating device) configured to produce a location signal when enabled (abstract and figures 1, 2, 5, and 6);

an interrogation signal (IS) communications transmitter or responder means 27 (telemetry transmitter) coupled to the LDS receiver/processor 31 (location-signal generating device) configured to transmit the location signal when enabled (abstract, figures 1, 2, 5, and 6, and column 5 lines 42-53); and

a controller 25 (enable controller) configured to wake-up (enable) the LDS

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receiver/processor 31 (location-signal generating device) and the IS communications transmitter or responder means 27 (telemetry transmitter) when it receives an interrogation (trigger) signal (IS) and, inherently, to put back to sleep (disable) the LDS receiver/processor 31 (location-signal generating device) and the IS communications transmitter or responder means 27 (telemetry transmitter) after the IS communications transmitter or responder means 27 (telemetry transmitter) transmits the location signal (abstract, figures 1, 2, 5, and 6, column 11 lines 26-40, column 12 lines 23-26, and claims 1-8).

Consider **claim 27**, and as applied to **claim 26** above, Janky et al. further disclose that the LDS receiver/processor 31 (location-signal generating device) comprises a GPS processor (abstract and column 11 lines 15-19).

Consider **claim 28**, and as applied to **claim 27** above, Janky et al. further show and disclose that the controller 25 (enable controller) is coupled to an IS communications receiver 21 (pager receiver) (abstract, figures 1, 2, 5, and 6, and column 6 line 65 - column 7 line 1) which produces an enable signal when it receives a page (column 8 lines 5-14).

Consider **claim 29**, and as applied to **claims 26 and 28** above, Janky et al. further disclose that the GPS processor generates the location signal in response to the enable signal (column 11 lines 31-35).

Consider **claim 30**, and as applied to **claims 28 and 29** above, Janky et al. further disclose that the GPS processor is in a “sleeper” mode (power is not applied) until the system receives a page (column 11 lines 35-40).

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Consider **claim 31**, and as applied to **claim 26** above, it is inherently taught by Janky et al. that power is also not applied to the IS communications transmitter or responder means 27 (telemetry transmitter) until the system receives a page since one of the motivations of Janky et al. when developing the system was to reduce power consumption by the system equipment (column 4 lines 46-62).

Consider **claims 32 and 33**, and as applied to **claim 26** above, Janky et al. further disclose that the IS communications transmitter or responder means 27 (telemetry transmitter) comprises a cellular telemetry transmitter or a satellite telemetry transmitter (column 7 lines 2-5).

Claims 1-11, 14, 16-22, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Janky et al. (U.S. Patent # 5,777,580)** in view of **Westerlage et al. (U.S. Patent # 5,826,195)**.

Consider **claims 1-4, 19, 20, and 22**, Janky et al. clearly show and disclose a vehicle location system (triggerable location-reporting apparatus) for use in an environment including: satellites 35A-D (source) outputting Global Positioning Satellite (GPS) System signals; a Vehicle Location Service Center (VLSC) 15 (source) outputting an interrogation (trigger) signal (IS) (page); a cellular base station connected through a network to a gateway; the cellular base station being configured to expect a Reverse Control Channel (RECC) signal including a Mobile Identification Number (MIN) and an Electronic Serial Number (ESN)

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(column 7 line 6 - column 8 line 4), the vehicle location system (triggerable location-reporting apparatus) comprising:

a power supply 34, 34' coupled to a power supply connection (figure 5 and column 13 lines 4-16);

a location determination system (LDS) receiver/processor 31 (GPS receiver) responsive to the GPS signals for producing GPS data when enabled (abstract, figures 1, 2, 5, and 6, and column 11 lines 15-19);

an IS communications transmitter or responder means 27 (cellular network transmitter) coupled to the LDS receiver/processor 31 (GPS receiver) for formatting and transmitting, when enabled, a RECC signal including the formatted GPS data to the gateway (abstract, figures 1, 2, 5, and 6, and column 5 lines 42-53);

an IS communications receiver 21 (trigger signal receiver) responsive to the IS (trigger signal) for producing an enable signal (abstract and figures 1, 2, 5, and 6);

a controller 25 (enable controller) coupled to the LDS receiver/processor 31 (GPS receiver), the IS communications transmitter or responder means 27 (cellular network transmitter), and the IS communications receiver 21 (trigger signal receiver) (figures 1, 2, 5, and 6);

the controller 25 (enable controller) being configured to wake-up (enable, switch on), by means of a first switchable power signal, the LDS receiver/processor 31 (GPS receiver) and, by means of a second switchable power signal, the IS communications transmitter or

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responder means 27 (cellular network transmitter) when it receives an enable signal from the IS communications receiver 21 (trigger signal receiver); and

inherently, the controller 25 (enable controller) being configured to put back to sleep (disable, switch off) the LDS receiver/processor 31 (GPS receiver) and the IS communications transmitter or responder means 27 (cellular network transmitter) (abstract, figures 1, 2, 5, and 6, column 11 lines 26-40, column 12 lines 23-26, and claims 1-8).

However, Janky et al. do not specifically disclose that the RECC signal includes the formatted GPS data in the place normally occupied by the ESN and the MIN that will cause the cellular base station to send a Registration Notification Invoke signal including the formatted GPS data to the gateway.

Westerlage et al. clearly show and disclose a data messaging system and a data messaging unit 16, equipped with a cellular transceiver 38, that generates a data message (e.g., GPS data) in response to a reporting event (trigger signal). Said data message (e.g., GPS data) is transmitted by the cellular transceiver 38, in a Reverse Control Channel, by altering the Electronic Serial Number (ESN) and the Mobile Identification Number (MIN) of the cellular transceiver 38. A cellular base station receives the data message and, after recognizing the altered identifier, forwards the message to a platform (gateway) (abstract, figures 1 and 2, column 1 line 62 - column 2 line 30, column 6 lines 55-65, column 9 lines 4-17, and column 10 line 16 - column 12 line 4).

Therefore, it would have been obvious to a person of ordinary skill in the art at the

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time the invention was made to slightly modify the teachings of Janky et al. with the teachings of Westerlage et al. in order to provide a triggerable location-reporting apparatus that takes advantage of existing communications protocols as well as existing cellular communications equipment at a reduced cost and complexity when communicating data messages in the place normally occupied by the ESN and the MIN, as recognized by Westerlage et al. (column 2 lines 6-13).

Consider **claims 5-7**, and as applied to **claim 4** above, Westerlage et al. further show and disclose that the power supply could be a battery, a vehicle battery, or a solar cell (figure 2 and column 7 lines 30-40).

Consider **claims 8, 9, and 11**, and as applied to **claim 2** above, Janky et al. further show and disclose that the location determination system (LDS) receiver/processor 31 (GPS receiver), the IS communications transmitter or responder means 27 (cellular network transmitter), and the IS communications receiver 21 (trigger signal receiver) are housed in a housing (figure 5) configured to be installed in a vehicle or in any object to be tracked (figures 1 and 2 and column 13 lines 4-16).

Consider **claim 10**, and as applied to **claim 8** above, although the combined teachings of Janky et al. and Westerlage et al. do not specifically disclose that the housing comprises at least a portion of an article of clothing, the Examiner takes Official Notice that is well known in the art of location monitoring to have location monitoring devices in at least part of an article of clothing, therefore, using the claimed apparatus in such environment would have

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been obvious to a person of ordinary skill in the art at the time the invention was made. Numerous references showing such feature have been cited by the Applicant as part of the information disclosure statements.

Consider **claim 14**, and as **applied to claim 1 above**, Janky et al. further disclose that the IS communications transmitter or responder means 27 (cellular network transmitter) comprises a cellular telephone (column 7 lines 2-5).

Consider **claim 16**, and as **applied to claim 1 above**, Janky et al. further disclose that the IS (trigger signal) comprises a page signal (column 5 lines 10-15).

Consider **claims 17 and 18**, and as **applied to claim 1 above**, Janky et al. further disclose that the source of IS (trigger signal) can be a vehicle trigger event sensor 36 (e.g., alarm, remote control, or the like) (column 12 line 43 - column 13 line 3).

Consider **claim 21**, and as **applied to claim 19 above**, Janky et al. further show and disclose receiving the location signal at an IS contact receiver 43 (e.g., gateway) and communicating the transmitted location to a VLSC 15 (service provider) (figures 1 and 2 and column 12 lines 16-42).

Consider **claim 24**, and as **applied to claim 19 above**, Janky et al. further disclose determining if the vehicle is moving and continuing to transmit the location of the vehicle while it is moving (column 12 lines 23-26).

Consider **claim 25**, and as **applied to claim 19 above**, Janky et al. further disclose storing the location of the vehicle (e.g., last known location) and transmitting the stored

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location of the vehicle if the ability to determine location ceases (column 11 lines 60-65 and column 12 lines 26-33).

(11) *New Ground(s) of Rejection*

This Examiner's Answer does not contain New Ground(s) of Rejection.

(12) *Response to Arguments*

A response to the arguments concerning the art rejections of claims 26-33 follows.

In the present application, Appellant argues that:

a) "Janky does not anticipate claims 26-33 because Janky does not include a controller that expressly or inherently disables the telemetry transmitter after it transmits the location signal, as required by claim 26" (page 3 section VIII of the brief); and that

b) "[t]he rejection of claims 26-33 can be upheld only if it is inherent in Janky for the enable controller to disable the location-signal generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal. This limitation is inherent in Janky only if the prior art in Janky necessarily includes the claimed limitations." (page 4 second paragraph of the brief).

In support of these arguments, Appellant cited, from *Continental Can Co., U.S.A. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20USPQ2d 1746 (Fed. Cir. 1991), that "[t]o serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in

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the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” (page 4 second paragraph of the brief), and that “[i]nherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.” (page 4 third paragraph of the brief).

The Examiner, as previously explained in the advisory action, respectfully disagrees with Appellant’s arguments because inherency can also be established “[i]f ... the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function”, see *Continental Can Co., U.S.A. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20USPQ2d 1746 (Fed. Cir. 1991), which is exactly the case in the present application.

Janky et al. clearly disclose an embodiment in which the LDS receiver/processor (location-signal generating device) is kept in a “sleeper” mode to conserve power until the IS receiver receives and **responds to the specified IS** (abstract lines 18-20). Moreover, in the same embodiment, Janky et al. further disclose that LDS receiver/processor (location-signal generating device) is awakened by the controller (enable controller) only when a trigger event occurs (column 11 lines 31-40) and that the IS responder/transmitter means 27 (telemetry transmitter) can contact the IS contact receiver **only once, as desired** (column 12 lines 24-26).

Therefore, it is clear from this embodiment (i.e., power saving mode) of Janky et al.

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that the controller (enable controller), inherently, disables the LDS receiver/processor (location-signal generating device) and the IS responder/transmitter means 27 (telemetry transmitter) after the IS responder/transmitter means 27 (telemetry transmitter) transmits the location signal.

Additionally, Appellant's examples, on page 4 last paragraph - page 5 first paragraph of the brief, is clearly focusing in a variation of the above-mentioned embodiment which is not the one relying upon by the Examiner. As explained above, Janky et al. is clearly providing support for the inherent teaching (i.e., controller (enable controller) disabling the LDS receiver/processor (location-signal generating device) and the IS responder/transmitter means 27 (telemetry transmitter) after the IS responder/transmitter means 27 (telemetry transmitter) transmits the location signal) when disclosing that the IS responder/transmitter means 27 (telemetry transmitter) can contact the IS contact receiver **only once, as desired**.

In response to the Examiner's arguments above, Appellant further argues that:

a) "Janky discloses that "the controller 25 causes the IS responder/transmitter means 27 and associated IS antenna 29 to contact a selected IS contact number at an IS contact receiver 43." (column 12, lines 16-18, emphasis added) Subsequently, "the IS responder/transmitter means 27 transmits the vehicle location information in a short burst of data contained in an IS response signal, in step 63." (column 12, lines 20-22, emphasis added) As can be seen, Janky uses "contact" to describe creating the communications link between the IS responder/transmitter means 27 and the IS contact receiver 43, and "transmit" to describe

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transmitting the vehicle information” (page 5 second full paragraph of the brief), and that:

b) “In the pivotal language relied on by the examiner, “the IS responder/transmitter means 27 may contact the IS contact receiver 43 only once, as desired,” column 12 lines 25, 26, Janky used the verb associated with setting up the communications link (“contact”), not the verb associated with transmitting the vehicle information (“transmit”). Thus, this language is referring to setting up a communications link only once, not transmitting the vehicle location information only once.” (page 5 last paragraph - page 6 first paragraph of the brief).


The Examiner respectfully disagrees with Appellant’s arguments because the meaning of the verb “contact” in the context relied upon by the Examiner (i.e., Janky et al., column 12 lines 23-26), and further explained in detail below, also encompass the transmission of the vehicle location information.

Janky et al. clearly teach, on column 12 lines 16-26, that “[i]n step 61, the controller 25 causes the IS responder/transmitter means 27 and associated IS antenna 29 to contact a selected IS contact number at an IS contact receiver 43, which be coincident with the VLSC 15 or may be separated from the VLSC. The IS responder/transmitter means 27 transmits the vehicle location information in a short burst of data contained in an IS response signal, in step 63. The vehicle present location information can be **updated continuously or intermittently**, or the IS responder/transmitter means 27 may contact the IS contact receiver 43 only once, as desired” (EMPHASIS ADDED).

It is clear from the above-mentioned teaching (specifically lines 23-26) that Janky et al.

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Therefore, in view of the above reasons and having addressed each of Appellant's arguments, it is believed that the rejection should be sustained.

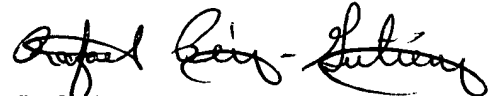

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